

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Jennipher Grudzien, et al
Serial Number: 10/784092
Filing Date: February 20, 2004
Examiner/Art Group Unit: Levkovich, Natalia A./1797
Title: REACTION SURFACE ARRAY DIAGNOSTIC APPARATUS

PETITION

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Applicants petition to the commissioner to require the Examiner to withdraw the finality of the Office Action dated April 20, 2009 and issue a new Action containing all of her rejections.

It is respectfully submitted that the Examiner intends to raise rejections on Appeal which were not raised in the Final Office Action.

In the Final Office Action dated April 20, 2009, the only rejections raised by the Examiner were under 35 USC§112, 1st and 2nd paragraphs. Applicants' after final amendment addressed these §112 rejections and apparently, the Examiner has agreed as indicated by her comments in the Advisory Action.

During a telephone interview prior to the filing of Applicants' After Final Amendment, the Examiner indicated that even if the 112 rejections were overcome, she would still raise the previous art rejections from prior Office Actions. The Examiner has also asserted this in the Advisory Action.

It is respectfully submitted that the Examiner is attempting to include rejections in the Final Office Action which do not appear in the final Office Action. Applicant adequately addressed the §112 rejections in the final Office Action thereby removing all rejections raised in the final Office Action.

MPEP §706.07 cite 37 CFR 1.113(b):

In making such final rejection, the Examiner shall repeat or state all grounds of rejection and then consider it applicable to the claims in the application, clearly stating the reasons and support thereof. It is respectfully that the Examiner has not met this requirement.

It is further submitted that the Examiner has not addressed Applicants' claim amendments and arguments submitted on November 10, 2008 as a response to the non-final Office Action dated July 9, 2008. In the non-final Office Action of July 9, 2008, the Examiner raised art rejections which she now intends to reintroduce into this the prosecution of this application. Applicants' address these objections in the Amendment after a non-final Office Action filed November 10, 2008.

When the Examiner issued the final Office Action on February 3, 2009, the Office Action makes no mention of the art rejections. Applicants' attorney's first indication that the art rejections were not overcome and were still considered by the Examiner to be pending in this Application came in the telephone interview on April 17, 2009 when the Examiner stated that she intended to reinstate the art rejections upon further action.

Thus, Applicants' have not received an opinion from the Examiner to Applicants' claim as to the affect of Applicants' claim amendments submitted in the non-final Amendment on November 10, 2008 on the art rejections raised by the Examiner in the non-final Office Action dated July 9, 2008.

Nor have Applicants' attorney received any opinion from the Examiner on Applicants' arguments distinguishing Applicants' claimed invention from the art rejections made by the Examiner. In essence, Applicants' are being denied a full and complete consideration of the non-final amendment dated November 10, 2008 since the Examiner has not responded in an Office Action to Applicants' amendment.

It is respectfully requested that the Commissioner of Patents and Trademarks:

1. Require the Examiner to withdraw the finality of the Office Action dated February 3, 2009 and issue a new Final Office Action containing all rejections made by the Examiner,

2. Enter the After Final Amendment filed May 7, 2009 overcomes the 35 USC §112 rejections raised by the Examiner in the Final Office Action.

As noted by the Examiner in the Office Action, the Examiner advised Applicants' attorney during the telephone interview that she would again raise the art rejections. Applicants' attorney protested that this was in accordance with Patent Office regulations since the art rejections were not raised in the Final Office Action, and therefore presumed to have been overcome by Applicants' previous Amendment filed on November 10, 2008.

The Examiner's actions, if not overturned, will require the Applicants to file a Request for Continue Examination (RCE) and pay the appropriate fee since the issues for appeal are not adequately defined in the Final Office Action. If Applicants file an RCE requiring the Examiner to enter the After Final Amendment, it is submitted that the §112 rejections raised in the Final Office Action will be removed and the previous art rejections noted by the Examiner in Advisory Action will be reintroduced.

This places the Applicants in an inequitable position of having to pay an additional RCE filing fee to merely have the Examiner make the art rejections of record in a current Office Action when such art rejections could have and should have been raised in the Final Office Action dated February 3, 2009.

Respectfully submitted,

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& HELMHOLDT, P.C.

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